

REMARKS

Claims 32-62 are added herein. Claims 1-62 now remain pending in the application.

Finality of the Office Action

The Office Action dated May 21, 2004 was indicated as being Final. The Finality of the Office dated May 21, 2004 was improper since failing to address all of the Applicants' arguments. In particular, the Applicants argued against McDowell as being improperly applied against the claims since 35 U.S.C. §102(e) that requires the cited prior art to be "an application for patent" that the Examiner had not responded to. The Examiner responded to the Applicants' arguments against the application of McDowell for the **FIRST TIME** in the Advisory Action dated September 23, 2004. The Examiner has again failed to address the fact that the Examiner ignored the Applicant's arguments against the application of McDowell in the Office Action dated May 21, 2004.

Therefore, the Applicants again respectfully request that the Finality of the Office Action dated May 21, 2004 be withdrawn.

Priority Date of McDowell

The Examiner alleges that McDowell's provisional application date of January 26, 2000 is McDowell's priority date according to 35 U.S.C. 119.

The Examiner is correct that 35 U.S.C. 119(e)(1) governs the right of an application for patent to claim priority to an earlier date based on a previously filed provisional application. However, the Applicants are not arguing the right of McDowell to claim priority to an earlier filed provisional application for McDowell's claims. The Applicants are arguing the rejection of the claims under the statutory language of 35 U.S.C. §102(e) that governs the application of McDowell against the Applicants' claims.

The Examiner alleges that since McDowell claims priority to the provisional application no. 06/178,142, filed on January 26, 2000, it is determined

that McDowell has privilege to the earlier provisional filing date of January 26, 2000 (Advisory Action, page 2). The Applicants respectfully agree and disagree.

Although a patent application can claim priority to a provisional application, the patent application only has priority to matter that is disclosed in the provisional application. A later filed patent application that **fails to have support** for matter disclosed in the provisional application therefore can not claim priority to matter not disclosed at the earlier time.

For example, a patent is filed and the Applicant later decides to add additional matter to the disclosure. The disclosure is rejected for new matter because if the new matter were allowed to remain it would get the benefit of the earlier filing date. The same is true of a patent application based on a provisional application. Matter not disclosed until a later time can not get the benefit of an earlier filing date.

McDowell is a publication of a patent application filed on January 26, 2001, which is its relevant 35 U.S.C. §102(e) date. This does not predate the filing date of the present application. The provisional application filing date, January 26, 2000, that the Examiner has apparently underlined can not be relied on since the degree of disclosure on that date is UNKNOWN. The publication of the later filed McDowell application is not prior art with respect to the claims of the present application. If the Examiner continues to rely on McDowell, the Applicants **again** respectfully request a copy of the provision application McDowell is based on to access the degree of disclosure on January 26, 2000.

Moreover, 35 U.S.C. §102(e) requires the cited prior art to be "an application for patent". A provisional application is **NOT** an application for patent as required by the statute. McDowell's patent application filed on January 26, 2001 is an application for patent as referred to in 35 U.S.C. §102(e). Therefore, McDowell does not qualify as prior art under 35 U.S.C. §102(e).

The Applicants respectfully request the Examiner address the statute the Examiner relies on to reject the Applicants' claims, 35 U.S.C. §102(e).

Claims 1-16, 20-25 and 29-31 over McDowell

In the Office Action, claims 1-16, 20-25 and 29-31 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by McDowell et al., U.S. Patent Application Publication US2001/0034224 A1 ("McDowell"). The Applicants respectfully traverse the rejection.

As discussed above, McDowell is not prior art with respect to the claims of the present application.

Accordingly, the rejection of claims 1-16, 20-25 and 29-31 is improper over the McDowell Application Publication cited. It is therefore respectfully requested that the rejection be withdrawn.

Claims 17-19 and 26-28 over McDowell in view of Sandegren

In the Office Action, claims 17-19 and 26-28 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over McDowell in view of Sandegren, U.S. Patent No. 6,512,930 ("Sandegren"). The Applicants respectfully traverse the rejection.

As discussed above, McDowell is not prior art with respect to the claims of the present application. The rejection on its face cannot stand on Sandegren alone.

Accordingly, the rejection of claims 17-19 and 26-28 is improper over the McDowell cited. It is therefore respectfully requested that the rejection be withdrawn.

Comments for McDowell and Sandegren

Claims 1-31 are amended herein to respectively recite a method and apparatus forwarding a registration notification message and an MSInactivity message from a short message service center to a device outside of a wireless network.

McDowell discloses that all messages two devices attached to a wireless network that are also attached to an IP Network/Internet, i.e., a WAP server and a Mobile Event Server (Fig. 1). Any notification of an event

associated with a wireless device would have to be routed through the WAP server or alternately through a HLR and the Mobile Event Server (McDowell, Fig. 1). Thus, McDowell's short message service center relies on other devices to convey any information to the Internet, much less any type of notification message.

Thus, McDowell fails to disclose a method and apparatus forwarding a registration notification message and an MSInactivity message from a short message service center to a device outside of a wireless network, as recited by claims 1-16, 20-25 and 29-31.

Sandegren appears to disclose a system that notifies a first user of a mobile communication device about status of other users in a mobile communications system (Abstract). A user can establish a list of individuals whose status is of interest to him (Sandegren, col. 3, lines 1-3). The list of individuals may be recipients of a call, a data transmission, or any other type of communication from a user (Sandegren, col. 3, lines 3-6).

Sandegren discloses all of the messages within the system are sent to components within the wireless system. Sandegren fails to disclose or suggest forwarding any type of messages outside of the wireless system over an Internet connection, much less disclose or suggest a method and apparatus forwarding a registration notification message and an MSInactivity message from a short message service center to a device outside of a wireless network, as recited by claims 1-31.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,
MANELLI DENISON & SELTER PLLC

A handwritten signature in black ink, appearing to read 'William H. Bollman', written over a horizontal line.

William H. Bollman
Reg. No.: 36,457
Tel. (202) 261-1020
Fax. (202) 887-0336

2000 M Street, N.W. 7th Floor
Washington D.C. 20036-3307

WHB/df